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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/808,309	03/25/2004	Naoki Hasegawa	20-137	5487

7590 10/19/2006

Arnold International
P.O. Box 129
Great Falls, VA 22066

EXAMINER

SMITH, PHILIP ROBERT

ART UNIT	PAPER NUMBER
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3739

DATE MAILED: 10/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/808,309

Applicant(s)

HASEGAWA, NAOKI

Examiner

Philip R. Smith

Art Unit

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 1, 2 and 8-16 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 17 and 18 is/are allowed.
- 6) ☒ Claim(s) 3-5 is/are rejected.
- 7) ☒ Claim(s) 6 and 7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

- [01] The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
- [02] In view of the verified translation of Applicant's priority document, the publication of Tokuda's patent application (2004/0097791) has been antedated. The corresponding rejections under 35 U.S.C. 102(e) are withdrawn.
- [03] The rejection under 35 U.S.C. 102 with regard to Furnish are withdrawn.
- [04] Claims 3-5 are rejected under 35 U.S.C. 102(b) as being anticipated by Mitsui (3,889,662).
- [05] With regard to claim 3: Mitsui discloses an endoscope comprising:
- [05a] an observation unit (comprising "view window 15b," "prism 21," "objective lenses 20" and "fiber bundle 18," 3/9-47); and
 - [05b] an illumination unit (comprising "illumination window 22a" and "light guide 23a," 3/9-47) that illuminates an illumination field;
 - [05c] the observation unit disclosed by Mitsui includes an objective optical system having an observation field of view and an in-focus position; and
 - [05d] the observation field of view of the objective optical system at the in-focus position of the objective optical system does not overlap said illumination field (see Figure 2).

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[06] With regard to claim 4: Mitsui discloses an endoscope comprising:

[06a] an image pickup unit (as noted above) having an observation field of view, the image pickup unit including an objective optical system that forms a magnified image of an object in the observation field of view such that the absolute value of the image scale factor is larger than 1 ("[a]mplifying lenses are used as the objective lenses 20," 4/23); and

[06b] an illumination unit (as noted above);

[06c] wherein the image pickup unit and the illumination unit are positioned so that the observation field of view of the image pickup unit at the in-focus position does not overlap the illumination field of the illumination unit (as noted above).

[07] With regard to claim 5: As noted above, Mitsui discloses an endoscopic illumination method in which a light source that does not directly illuminate an observation field of view illuminates an area of tissue outside the observation field of view, and said area of tissue scatters the light from the light source so as to illuminate the observation field of view. It is probable that in the course of normal use, light from Mitsui's "22a" will be scattered by tissue and end up illuminating the view field of Mitsui's "15b."

Allowable Subject Matter

[08] Claims 17 & 18 are allowed.

[09] Claims 6 & 7 are objected to as being dependent upon a rejected base claim, but

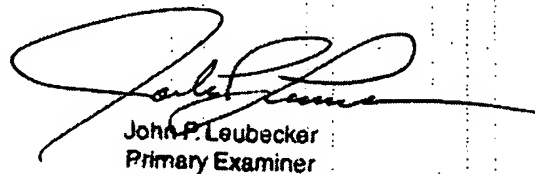
would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Response to Arguments

- [10] Applicant's arguments filed 7/21/06 are persuasive. The rejections under 35 U.S.C. 102 with regard to Furnish are withdrawn.

Conclusion

- [11] Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip R. Smith whose telephone number is (571) 272 6087 and whose email address is philip.smith@uspto.gov. The examiner can normally be reached between 9:00am and 5:00pm.
- [12] If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272 4764.
- [13] Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



John P. Leubecker
Primary Examiner